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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,921	02/19/2004	Peter C. Salmon	34074/AJT	7265
7590	10/18/2005		EXAMINER	NGUYEN, ANTHONY H
Aldo J. Test DORSEY & WHITNEY LLP Suite 3400 4 Embarcadero Center San Francisco, CA 94111			ART UNIT	PAPER NUMBER
2854				
DATE MAILED: 10/18/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/783,921	SALMON, PETER C.
	Examiner Anthony H. Nguyen	Art Unit 2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 05 August 2005.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-24 is/are pending in the application.  
 4a) Of the above claim(s) 13 and 19-24 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-12 and 14-18 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 19 February 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>2/19/2004</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

Applicant's election of Group I, claims 1-12 and 14-18 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Accordingly, claims 13 and 19-24 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

### ***Claim Rejections - 35 U.S.C. § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 2 are rejected under 35 U.S.C. 102(a), (e) as being anticipated by Thiebaud et al. (US 2003/0206832).

Thiebaud et al. teaches an embossing tool 200 having a transparent substrate 220 (Thiebaud et al., paragraph [0024]), alignment features 212, 214, 216 for aligning

the embossing tool with the substrate being embossed (Thiebaud et al., paragraph [0046]), an embossing material 30 covering the center portion of the substrate and raised embossing features patterned in the embossing material as shown in Figs. 2 and 3 of Thiebaud et al.

### **Claim Rejections - 35 U.S.C. § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-6, 10,11,14, 15 and 18 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Walz et al. (US 2003/0135998) in view of Thiebaud et al. (US 2003/0206832).

With respect to claims 14-16, Walz et al. teaches an embossing machine 21 having a chamber 7 enclosing an embossing tool 9, a substrate 1 and a means ( no numeral reference) for applying a normal force between the embossing tool and the substrate (Figs.1, 1a and paragraph [0048]). Walz et al. does not teach the means for optical aligning the embossing tool. Thiebaud et al. teaches the embossing tool having a means 14, 24 for optical aligning the tool as shown in Fig.1 of Thiebaud et al. In view of the teaching of Thiebaud et al., it would have been obvious to one of ordinary skill in

the art to modify the embossing machine of Walz et al. by providing the optical aligning means as taught by Thiebaud et al. to permit more precise aligning of an embossing tool and a substrate for embossing. Also, note that the use of an optical means for aligning two pieces of substrates or parts is well known in the art. With respect to claims 3, 5 and 6, Walz et al. teaches that a conductive material is coated on the surface of the features (Walz et al., paragraph [0044]). Therefore, the use of nickel or the Cytop and the taper angle for the embossing feature recited involve no apparent unobviousness. With respect to claims 4, 10 and 11, the selection of a desired taper angle for the sidewalls of the embossing features and the material used for the substrate involve only an obvious matter of design choice based upon obvious experimentation.

Claims 7-9 and 12 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Thiebaud et al. (US 2003/0206832) in view of Atkinson (US 3,841,557).

With respect to claims 7, 8 and 12, Thiebaud et al. teaches all that is claimed except the heating resistor provided on the substrate. Atkinson teaches the use of heating resistors 174 provided in the substrate 50 (c) as shown in Fig.11 of Atkinson. In view of the teaching of Atkinson, it would have been obvious to one of ordinary skill in the art to modify the embossing tool of Thiebaud et al. by providing the heating resistors as taught by Atkinson for optimum embossing effects. With respect to claim 9, the selection of a desired material for the heating resistor would be obvious through routine experimentation in order to get best possible embossing quality.

Claims 16 and 17 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Walz et al. in view of Thiebaud et al. as applied to claims 14,15 and 18 above, and further in view of Atkinson (US 3,841,557).

Walz et al. and Thiebaud et al. teach all that is claimed except the co-resident means for heating for heating the embossing tool. Atkinson teaches the use of co-resident means or the heating resistors 174 provided in the substrate 50 (c) as shown in Fig.11 of Atkinson. In view of the teaching of Atkinson, it would have been obvious to one of ordinary skill in the art to modify the embossing tool of Walz et al. and Thiebaud et al. by providing the co-resident means or the heating resistors as taught by Atkinson for optimum embossing effects.

### ***Conclusion***

The patents Isaksson, Diem, and Chapel et al. are cited to show other structures having obvious similarities to the claimed structure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Nguyen whose telephone number is (571) 272-2169. The examiner can normally be reached daily from 9 AM to 5PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld, can be reached on (571) 272-2168.

The fax phone number for this Group is (571) 273-8300.

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10/11/05  
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